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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,223	01/16/2002	Martin Schaut	DT-6057	6390
30377	7590	11/17/2003	EXAMINER	
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			GAY, JENNIFER HAWKINS	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary

Application No.

10/050,223

Applicant(s)

SCHAUTT, MARTIN

Examiner

Jennifer H Gay

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Chromy (US 3,690,390) or Kleine (US 5,775,445).

Regarding claim 7: Chromy discloses a drilling head for a rock bit for a hand-held power tool. The drilling head includes the following features:

- A main bit (10).
- An auxiliary bit (11a) that is located exclusively in a radially outward region of the drilling head and completely radially outwardly of the main bit.
- The auxiliary bit includes an arcuate cutting edge (see Figure 3) where the edge is circumferentially axially rounded.

Regarding claims 8 and 9: As seen in Figures 1, 3, and 4, the main bit includes two, diametrically offset, cutting edges that are connected at a drilling head tip.

Regarding claim 10: The auxiliary bit is axially offset with respect to the generation curve of the main bit.

Regarding claim 7: Kleine discloses a drilling head for a rock bit for a hand-held power tool. The drilling head includes the following features:

- A main bit (2b).
- An auxiliary bit (1) that is located exclusively in a radially outward region of the drilling head and completely radially outwardly of the main bit.

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- The auxiliary bit includes an arcuate cutting edge (1a, see the figure) where the edge is circumferentially axially rounded due to the drill bit being a hollow, annular member.

Regarding claims 8 and 9: As seen in the figure, the main bit includes two, diametrically offset, cutting edges that are connected at a drilling head tip.

Regarding claim 10: The auxiliary bit is axially offset with respect to the generation curve of the main bit.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kleine (US 5,775,445) or Chromy (US 3,690,390).

Kleine discloses a drilling head for a rock bit for a hand-held power tool. The drilling head includes the following features:

- A main bit (2b).
- An auxiliary bit (1) that is located exclusively in a radially outward region of the drilling head and completely radially outwardly of the main bit.
- The auxiliary bit includes an arcuate cutting edge (1a, see the figure) where the edge is circumferentially axially rounded due to the drill bit being a hollow, annular member.

Kleine discloses all of the limitations of the above claims except for the auxiliary bits forming a pointed wedge angle of between 50° and 80°. However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the auxiliary bits of Kleine with a pointed wedge angle between

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50° and 80°, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Chromy discloses a drilling head for a rock bit for a hand-held power tool. The drilling head includes the following features:

- A main bit (10).
- An auxiliary bit (11a) that is located exclusively in a radially outward region of the drilling head and completely radially outwardly of the main bit.
- The auxiliary bit includes an arcuate cutting edge (see Figure 3) where the edge is circumferentially axially rounded.

Chromy discloses all of the limitations of the above claims except for the auxiliary bits forming a pointed wedge angle of between 50° and 80°. However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the auxiliary bits of Chromy with a pointed wedge angle between 50° and 80°, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

5. Applicant's arguments with respect to claims 7-11 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed 22 September 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Musacchia does not teach that the auxiliary bit is provided exclusively in a radially outer region of the drill head completely radially outwardly of the main bit, the examiner disagrees. Figures 8 and 11 of

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Musacchia clearly show that the portions that the examiner considers the auxiliary bit are located completely radially outwardly of the main bit. However, the examiner has noted that Musacchia does not teach that the cutting edge of the auxiliary bit is axially rounded.

Conclusion

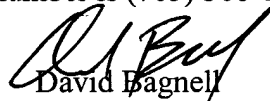
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The remaining references made of record disclose various rock bit similar to those described above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

JHG
November 6, 2003